

Serial No: 08/870,199
Filed: June 5, 1997
Docket: 1560B US

REMARKS

I. Summary

Claims 1-56 are pending in the present application and claims 1-56 have been rejected by the final Office Action mailed April 19, 2007. The issues in the Office Action are:

- Claims 27-56 are objected to as being improperly presented under 37 C.F.R. §1.173(d);
- Claim 13 is rejected under 35 U.S.C. § 251 as being improperly broadened;
- Claims 13-23 are rejected under 35 U.S.C. § 112, first paragraph as being unsupported by the specification;
- Claims 27-30 are rejected under 35 U.S.C. § 112, first paragraph as being unsupported by the specification; and
- Claims 1-56 are rejected as being based on a defective reissue declaration.

Applicant respectfully traverses the objections and rejections of record for the reasons presented herein.

Applicant respectfully notes that this reissue application was filed over a decade ago on June 5, 1997. Applicant believes that the remarks presented herein should resolve the final outstanding issues in the prosecution of this application. Should the Examiner or her colleagues involved in the review of this reissue application believe that there are issues unresolved by this response, Applicant would greatly appreciate it if the involved personnel would contact the undersigned by telephone at (817) 615-5080 to discuss a path forward to allowance.

II. Objections to Claims 27-56

Claims 27-56 are objected to as being improperly presented under 37 C.F.R. §1.173(d). Applicant notes that the Office Action states that claims 27-58 have been objected to; however, claims 57 and 58 were canceled in the response filed by Applicant on December 22, 2006. Accordingly, Applicant believes no further remarks regarding claims 57 and 58 are necessary.

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Claims 27-56 have been underlined and marked by Applicant with an appropriate status identifier as required by 37 C.F.R. §1.173(b) and (d).

Claims 27-30 were first added in the original reissue application filed on June 5, 1997, comprising a first amendment relative to the patent. The text of claim 27 was amended again on April 16, 1999, February 3, 2000, and January 24, 2003. Applicant believes that the correct status identifier for claim 27 is “amended four times” and for claims 28-30 is “amended”.

Claims 31-56 correspond to original claims 1-26 in the issued patent. 37 C.F.R. §1.173(b) requires that the status identifier for a claim changed by an amendment paper reflect “amended”, “twice amended”, etc. Claims 31-56 were added by amendment on September 19, 2000, withdrawn from consideration by the Examiner on November 9, 2001, and reamended to the application on May 9, 2002. The text of claims 31-56 has not been further amended after May 9, 2002. Applicant believes that the correct status identifier for these claims is “amended”, which is reflected in the above listing of claims.

Applicant has also reviewed the previous responses made in this prosecution and has updated the status identifiers and appropriately marked the text relative to the issued patent for claims 1, 13, and 25.

Applicant believes that claims 27-56 are correctly presented in the listing of claims above and respectfully requests that the Examiner withdraw her objection to these claims.

II. Rejection of Claim 13 under 35 U.S.C. § 251

Claim 13 has been rejected under 35 U.S.C. § 251 as being improperly broadened in a reissue application filed outside the two year statutory period. The core of the Examiner’s rejection appears to be the removal of the limitation “the series including a final filter having a 0.5 μ m opening.”

The above-recited limitation was first removed from claim 13 by amendment in the original reissue application filed on June 5, 1997. 35 U.S.C. § 251 provides that “no reissued patent shall be granted enlarging the scope of the claims of the

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original patent unless applied for within two years from the grant of the original patent.” The original patent (U.S. Patent No. 5,422,376) was granted June 6, 1995. The reissue application was applied for on June 5, 1997. Thus, 35 U.S.C. § 251 does not operate to prevent broadening amendments.

Applicant believes that the Examiner’s argument centers on the recapture doctrine discussed in MPEP 1412.02. Applicant respectfully requests that the Examiner reference the Reissue Recapture chart in MPEP § 1412.02. Taken in isolation, the removal of the limitation “the series including a final filter having a 0.5 μ m opening” from claim 13 broadens the scope of claim 13. Accordingly, the answer to the first decision box below the start box is “yes”.

As discussed above, the reissue application was filed within two years of the patent grant. Accordingly, the answer to the second decision box below the start box is “yes”.

The limitation at issue was not added by amendment to narrow the claims during prosecution resulting in the issued patent. Accordingly, the answer to the third decision box below the start box is “no”.

Applicant requests that the Examiner direct her attention horizontally to the fourth and last decision box, which asks whether “an argument or a statement was made by the applicant that *a specific claim limitation* defined over the prior art.” (emphasis added). The answer to this question is also “no”. The objected-to limitation was never used to define the invention over the prior art. The undersigned has reviewed the prosecution files for the issued patent and for the abandoned parent application (S/N 08/055,822) and can find no references to the objected-to limitation made in any response by Applicant. In Applicant’s responses, the invention was generally distinguished over the prior art on the basis of the particulate matter present in the compositions of the present invention, not the filters used to produce such a solution. *See, e.g.* August 24, 1994 Response; S/N 08/240,941. Thus, on the basis of this analysis, the MPEP 1412.02 decision tree states that “there is no recapture”. Accordingly, the removal of the limitation at issue was proper under 35 U.S.C. § 251 and MPEP 1412.02.

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For the above reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 13.

III. Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 13-23 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claim 13 comprises the phrase “filtering the gel through a series of filters”. Claims 14-23 depend directly or indirectly from claim 13, and thus also comprise this phrase. Col. 6, lines 3-12 specifically discusses filter series that may be used with embodiments of the present invention and also specifically discusses a filter series that was found to be suitable. If the Examiner’s rejection is based upon an assertion that the specification does not include the exact words of the claim, Applicant respectfully reminds the Examiner that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement,” M.P.E.P. § 2163.02.

Claims 27-30 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claim 27 comprises the phrase “harmful to the human eye” as part of the larger phrase “substantially free of particulate matter and gels greater than 0.5 μm in diameter and harmful to the human eye.” Claims 28-30 depend directly or indirectly from claim 27, and thus also comprise this phrase. Col. 4, lines 12-20 specifically describes harmful particulate matter. Generally, the specification describes harmful particulate matter and gels from col. 1, line 9-col. 4, lines 19. Again, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement,” M.P.E.P. § 2163.02.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 13-23 and 27-30 under 35 U.S.C. § 112, first paragraph. The specification fully satisfies the written description requirement, as one of skill in the art would understand that the phrases at issue are fully supported by corresponding descriptions in the specification.

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IV. Reissue Declaration

Claims 1-56 are rejected as being based on a defective reissue declaration. The Examiner states that the original declaration does not indicate certain limitations that were added to the claims.

A Supplemental Declaration under 37 C.F.R. § 1.175(b) and dated April 4, 2004 ("Supplemental Declaration") was filed in this case with the May 6, 2004 Response. A copy of the Supplemental Declaration was also filed for the convenience of the Examiner with the most recent response filed on December 22, 2006.

The Supplemental Declaration comprises Exhibit B which is a listing of claims that corresponds to the listing of claims above. The undersigned has compared the listing of claims above with the claims listed in Exhibit B of the Supplemental Declaration and found them to be substantially identical with the exception of status identifiers and bracketing/underlining. Applicant affirms in the Supplemental Declaration that he has reviewed and understands the scope of the Exhibit B claims. Paragraph 6 of the Supplemental Declaration also references the amendments discussed above, including by reference the amendments in Exhibit B. Paragraph 6 is substantially of the form required by 37 C.F.R. § 1.175(b) and MPEP 1414.01.

In the responses filed by Applicant subsequent to the filing of the Supplemental Declaration, no further amendments have been made to the claims other than a wholesale deletion of claims 57 and 58. Claims 57 and 58 were not present in the issued patent and their deletion does not result in a correction to an error in the issued patent that is required to be addressed by a § 1.175(b) declaration.

In view of the above, Applicant respectfully asserts that the Supplemental Declaration is in compliance with the requirements of 37 C.F.R. § 1.175(b) and MPEP 1414.01 relative to the listing of claims above. Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-56 as being based on a defective declaration.

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V. Improper Finality

Applicant respectfully asserts that the Examiner has improperly made this action final. The Examiner states that "the newly submitted amendments necessitate the new ground of rejection." Applicant's December 22, 2006 Response made no amendments to the claims and Applicant respectfully directs the Examiner to the italicized statement on page 13, paragraph 2 of that Response. Because no amendments were made by Applicant in the previous Response, finality is improper when the Examiner is raising new objections and rejections to the pending application. Therefore, Applicant respectfully asserts that the finality of this Office Action is improper under M.P.E.P. § 706.07(a). Accordingly, Applicant respectfully requests, pursuant to M.P.E.P. § 706.07(c), that the Examiner reconsider the final status of the Office Action and withdraw the finality of the rejection pursuant to M.P.E.P. § 706.07(d).

VI. Conclusion

For the above reasons, Applicant believes that the pending application is in condition for allowance. Again, Applicant respectfully requests that any USPTO personnel involved with the review of this application contact the undersigned via telephone to discuss resolution of any remaining issues and ensure that prosecution of this case can finally be brought to conclusion.

Respectfully submitted,

August 24, 2007

Date

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